

REMARKS

Claims 1, 2, 4, 6 through 13, 15, 17 through 23, 25, 27 through 33, 35, 37 through 45, 47, 49 through 51, 53, 55 through 58, 60, 62, 64 through 67, and 71 through 84 are currently pending in the application, claims 76 through 84 being newly added with this amendment.

Claims 3, 5, 14, 16, 24, 26, 34, 36, 46, 48, 52, 54, 59, 61, 63, 68, 69, and 70 have been canceled.

This amendment is in response to the Office Action of August 12, 2003.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 75 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the claimed invention as suggested by the Examiner for the presently claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112. Therefore, presently amended claims 1, 2, 4, 6 through 13, 15, 17 through 23, 25, 27 through 33, 35, 37 through 45, 47, 49 through 51, 53, 55 through 58, 60, 62, 64 through 67, and 71 through 75 as well as claims 76 through 84 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 103(a) Rejections

Claims 1 through 6, 10 through 17, 21 through 27, 31 through 37, 41 through 49, 51 through 55, 57 through 64 and 66 through 73 were previously rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh (U.S. Patent 6,338,980) in view of Bennett et al. (U.S. Patent 6,478,918). Applicants respectfully traverse this rejection, as hereinafter set forth.

Claims 7 through 9, 18 through 20, 28 through 30, 38 through 40, 50, 56, 65, 74 and 75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Satoh (U.S. Patent 6,338,980) in view of Bennett et al. (U.S. Patent 6,478,918) as applied above, and further in view of the admitted prior art.

Applicants assert that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicants have amended the claimed invention to clearly distinguish over the cited prior art and added new claims to clearly distinguish over the cited prior art.

Applicants assert that any combination of either the cited prior art Satoh reference and the Bennett et al. reference or the cited prior art Satoh reference and the Bennett et al. reference and further the Applicants' admitted prior art does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of presently amended independent claims 1, 12, 23, 33, 45, 51, 57, and 67 because any proposed combination of such cited prior art, at the very least, fails to teach or suggest all the claim limitations of the presently claimed inventions and is merely an attempt at a hindsight reconstruction of the presently claimed inventions based solely upon the Applicants' disclosure, not the teachings or suggestions of the cited prior art. Applicants submit that any combination of the cited prior art fails to teach or suggest the claim limitations of the presently claimed inventions calling for "conforming at least a portion of said adhesive of said tape to said bumps to form a substantially planar surface on said backing of said tape" "an adhesive tape having an adhesive and a planar backing for a vacuum attachment, said adhesive tape for adhesively attaching a portion of said front surface of said wafer having said at least one bump thereon to a portion of said wafer mount assembly by said planar backing for a vacuum attachment", and "a tape having an adhesive and a planar backing for vacuum attachment, said tape for adhesively attaching a portion of said front surface of said wafer having said at least one bump thereon".

Applicants assert that any proposed combination of the cited prior art of the Satoh reference, the Bennett et al. reference, and the admitted prior art does not and cannot teach or suggest all such claim limitations of the presently claimed inventions of the amended independent claims as set forth above because there are no such teachings or suggestions whatsoever in such cited prior art. The Satoh reference contains no teaching or suggestion whatsoever as the adhesive having a backing, which is recognized in the Office Action. Since the Satoh reference does not have any backing on the adhesive, the Satoh reference can contain no teaching or suggestion as to any reasons whatsoever for the inclusion of a backing on the adhesive. Applicants claimed inventions use an adhesive having a backing for either “conforming at least a portion of said adhesive of said tape to said bumps to form a substantially planar surface on said backing of said tape” “an adhesive tape having an adhesive and a planar backing for a vacuum attachment, said adhesive tape for adhesively attaching a portion of said front surface of said wafer having said at least one bump thereon to a portion of said wafer mount assembly by said planar backing for a vacuum attachment”, or “a tape having an adhesive and a planar backing for vacuum attachment, said tape for adhesively attaching a portion of said front surface of said wafer having said at least one bump thereon” so that a better vacuum can be applied to the wafer for operations thereon. (See, at least paragraph [0036] of Applicants specification.) Applicants assert that Satoh clearly has no idea of any advantage of a backing for the adhesive, nor has there been any showing in the cited prior art of such knowledge, nor has there been any showing of such knowledge in the Bennett et al. reference, nor the admitted prior art to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention. The only basis for any such teaching or suggestion is in Applicants’ disclosure (See, at least, paragraph [0036]). Additionally, Applicants assert that the Satoh reference, as well as any other references of the cited prior art, of any teaching, or suggestion, or need, or desire or reason to have the adhesive to be “substantially planar” as set forth in the presently amended claims. Solely Applicants’ disclosure contains any such teachings or suggestions. The cited prior art is devoid of any teaching or suggestion whatsoever as to a substantially planar adhesive backing.

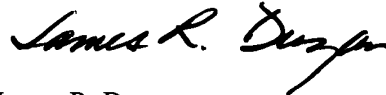
As such, Applicants further assert that the sole basis for any combination of the cited prior art is solely Applicants' disclosure, not the cited prior art as is required to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention, because there is no teaching or suggestion for the claim limitations of the presently claimed invention but, solely the Applicants' disclosure. Any rejection based in any part upon the Applicants' disclosure is clearly improper under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention.

Accordingly, since any combination of the cited prior art fails, at the least, to teach or suggest all the claim limitations of the presently claimed inventions of presently amended independent claims 1, 12, 23, 33, 45, 51, 57, and 67, Applicants assert such claims are allowable as well as the dependent claims therefrom.

Applicants further assert that new added claims 76 through 84 are allowable for the reasons set forth above.

Applicants request the allowance of claims 1, 2, 4, 6 through 13, 15, 17 through 23, 25, 27 through 33, 35, 37 through 45, 47, 49 through 51, 53, 55 through 58, 60, 62, 64 through 67, and 71 through 84 and the case passed for issue.

Respectfully submitted,



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